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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/080,065 | 02/19/2002 | Yevgeniy Eugene Shteyn | US 028015 | 8549 |

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Corporate Patent Counsel
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EXAMINER

MOSSEY, ROBERT E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3714

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080.065

Applicant(s)

SHTEYN, YEVGENIY EUGENE

Examiner

Robert Mosser

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 9th 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 11-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1- and , 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

♦
In response to amendment dated June 6th, 2004
Claims 1-7, and 11-13 are pending.
This Action is Final.
♦

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-7** and **11-13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims **1-7** and **11-13**.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

I. Technological Arts Analysis

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claims are directed towards a user's interaction with a "virtual environment", the detection of "innovative aspects", that "can deliver the user an advantage", and "grant the user a degree of exclusivity". As disclosed this represents a mere manipulation of abstract concepts, which is devoid of any tangible physical structure or practical application of technology therein beyond the nominal recitation of such in a "virtual environment" as defined by the specification.

I.A. Nominal recitation of technology

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, *even* if the "virtual environment set forth in the perceived preamble of claims 1-7 and 11-13, was held to be bound within the use of technology these recitations are not functionally incorporated into the body of the claim in such a manner as to provide functionality inter-connect process.

II. Useful, Concrete and Tangible Analysis

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. *["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue*

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experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]

In the present case, the detection of an innovative aspect represents a non-concrete result as though the user may perform an innovative aspect the detection of this is limited by the detecting system and further defined in that which is innovative to the determining system only at that instance of time. Further the limitation of "enabling to benefit" is non-definitive as there is no reliably predictable result in which the user would benefit from their innovative aspect if the user did not continue to utilize their innovative aspect, others were not interested in their innovative aspect, and/or their innovative aspect produced results less effective than a known aspect presently available. Furthermore, the result claimed in that the user "benefits" from registering the information. It is the examiners position that this "benefit" is not a tangible result.

Claims **2-7** and **13** fail to correct the deficiency of claims **1**, **11** and **12** presented above and ergo are rejected under the statute for the reasons laid forth herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1-7**, and **11-13** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, it does not appear as if the invention could be practiced to produce a concrete result without undue experimentation. The factors set forth for a determination of undue experimentation are set forth in MPEP 2164.01(a), following the analysis in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). In this case, the examiner has considered each of these factors in arriving at the conclusion that the invention could not produce a concrete result without undue experimentation. The evidence in the application file has been considered for each of these factors as a whole and all of the factual considerations have been weighed. Specifically, the intended operation of the process is to detect an innovative aspect in an interaction with a user. The factors used in the process are very subjective in nature (determining what is innovative and what is not.), with any result of the process being speculative at best. Applicant has not set forth any objective evidence or direction in the record that would lead one of ordinary skill in the art to be able to analyze these highly subjective factors and arrive at a specific, predictable result. The very low predictability of this invention due to the subjective nature of the elements used therein, coupled with the lack of direction provided by the specification and the subjective nature of the invention far outweigh all other *Wands* factors when considering the necessity for undue experimentation.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1-7**, and **11-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims **1, 11, 12** and claims **2-7, 13** through their dependence thereon. It is not clear what is meant by "innovative aspect" nor is it clear what is being subjected to the "enabling" steps.

Regarding claims **11-12** the use of the conditional statement "can" in the preamble without further laying forth when it would or would not perform the specified method and/or what steps would be performed is indefinite.

Regarding claims **1** and **11-12** the claimed "degree of exclusivity" is indefinite, as a degree may be understood to encompass any amount from 0% to 100%. While broad claims do not necessitate indefiniteness, in this case the determination by which this degree of exclusivity is determined is not set forth and as such would make the meets and bounds of the invention unclear to one of ordinary skill in the art.

Claims not directly addressed are incorporated in this rejection through their dependency on the rejected independent claims **1, 11, and 12**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Interplays "The Vault Dweller's Survival Guide" herein after referred to as DSG.

DSG teaches a computer (electronic) game released under the name "Fallout" wherein the player (character) wanders a post-nuclear landscape (virtual environment) including various hostile creatures (rats) in a labyrinth (the cave in the tutorial). The player is assigned "stats" including attributes as so claimed that evolve based on the player's interaction with the environment. Dependent on the player's interaction they are permitted to choose an innovative aspect (perk) that only the player is permitted to utilize (exclusive right) in the virtual environment and provides the player an advantage in the environment including a monetary reward associated with the Fortune Finder perk. DSG allows a player to share the information regarding their character's possession of perks with other characters conditionally dependent on the player choice to do so (see pages 2/1-2/6, 3/18, 2/20, 5/23-5/34 and appendix A).

Response to Arguments

Applicant's arguments filed June 9th, 2004 have been fully considered but they are not persuasive.

Applicant attempts to define enabling in language not presented in their specification as originally filed and in a manner inconsistent with it's commonly understood meaning. Further applicant fails to specify what is being enabled in the

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present claims and hence has not provided any support in the claim language for their intended use of "enabling".

Applicant has not addressed the requirement for corrected drawings and is reminded that failure to do so in the future may result in the holding of future amendments as non-responsive and/or the abandonment of their application.

Applicant's has not corrected the USC 101 issues present and seems to argue the "useful" aspect of the invention that has not presently been challenged.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



JESSICA HARRISON
PRIMARY EXAMINER